

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 3, 6-9 and 12-21 are still pending in this application. No new matter has been added.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. CLARIFICATION REQUESTED ON RESTRICTION REQUIREMENT

Applicants are unclear by the statement made in the final rejection which stated that “[n]o claims are now drawn specifically to the elected species, nor to the subject matter which was previously indicated as being commensurate in scope with other species for which data has been presented (and therefore allowable), i.e., the “A” group herbicides of formula X, in combination with sulfonylurea herbicides (see examples 1-22).”

The applicants elected (A1) 4-amino-6-(1-fluoro-1-methylethyl)-2-(3-phenyl-1-cyclobutylamino)-1,3,5-triazine (which is equivalent to N-(1-cyclopropyl-4-phenylbutyl)-6-(1-fluoro-1-methylethyl)-1,3,5-triazine-2,4-diamine) and fenoxaprop-P-ethyl (part of B1.3.3) with traverse.

Claim 19 is an independent claim and encompasses (A1) wherein R^1 is NH_2 , R^2 and R^3 is hydrogen, R^4 is hydrogen, R^5 is a $-B^1-Y^1$ wherein B^1 is a direct bond, Y^1 is a cyclic hydrocarbon radical having 3 to 8 carbon atoms (4 for (A1)), A is an alkylene radical having 1 to 5 straight-chain carbon atoms (3 for (A1)) and $n = 0$ and (B) is B1.3.3.

Each of the currently pending claims are either directly or indirectly dependent upon claim 19 and encompass the elected species of (A1) and B1.3.3. Therefore, it is unclear what the Examiner is referring to in the comment made above.

III. THE 35 U.S.C. 112, 1ST PARAGRAPH REJECTION (“Written Description”) HAS BEEN OVERCOME

Claims 3, 6-9 and 12-21 were rejected as allegedly failing to comply with the written description requirement, i.e. the applicants were alleged to have had no possession of the invention of the subject matter as claimed at the time of filing the application.

The initial burden for establishing lack of possession of the invention resides with the Office.¹ However, despite 4½ pages of boilerplate text regarding 1st paragraph rejections, no explanation was given as to why the present case fails to meet the written description requirement especially when the claims have been limited to the combination of (A1) and B1.3.3.

Moreover, any explanation for establishing lack of possession must overcome a significant evidentiary hurdle as it has previously been held that “To satisfy the description requirement of section 112, first paragraph, an application must contain sufficient disclosure, expressly or inherently, to make it clear to one skilled in the art that the appellant was in possession of the subject matter claimed...’[A] statement of the appellant’s invention [in his specification] which is as broad as appellant’s broadest claims’ is sufficient to meet this requirement.” see *In re Eickmeyer*, 202 USPQ 655, 662 (CCPA 1979).

Given this low threshold for complying with the written description requirement, the Office Action has not met the initial burden for establishing lack of possession and as such the rejection may be withdrawn.

The applicants have shown evidence of synergism in Examples 11 and 21 for the elected species. In Example 11, the applicants have shown 100% activity against *Capsella bursa-pastoris* for the combination of (A1) and B1.3.3. when individual testing would have predicted an activity of only 78%. Likewise, in Example 21, the activity for the combination of (A1) and B1.3.3 was 97% when the predicted an activity was 95%. Although this is a close level of activity, the testing of B1.3.3 yield 0% activity, i.e. the results are unexpected and synergistic because one of ordinary skill in the art would not have expected any increase in activity.

¹ MPEP 2163, section I. A. (“There is a *strong presumption that an adequate written description of the claimed invention is present when the application is filed.* In *re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (“we are of the opinion that the *PTO has the initial burden of presenting evidence or reasons* why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”) - emphasis added by applicants.

As such, there is no basis to assert that the applicants' claimed invention as examined lacks written description.

III. THE 35 U.S.C. 103 REJECTION HAS BEEN OVERCOME

Claims 2-4, 6-9 and 11-13 were rejected as being obvious over the combined teachings of Giencke et al. (U.S. Patent 6,239,071 - "Giencke"), Zindel et al. (WO 98/34925 - "Zindel"); Hirata et al. (A: EP 467 204; B: EP 469 406; C: EP 471 221; D: EP 471 284), Takematsu (Abstract of JP 04095003); Hirata et al. (A: Abstract of JP 7267804; B: Abstract of JP 7267805).

The applicants maintain their response from the response filed on 14 March 2007 as the only rebuttal in the previous Office Action was merely a statement that applicants' arguments were unpersuasive with no explanation as to why this was believed to be so.

When, as here, the applicants present a reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, *the entire merits of the matter are to be reweighed*. In *re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). The applicants' arguments should not have been judged for their knockdown ability with respect to the rejection.²

As noted above, the applicants have provided evidence of secondary considerations with regard to unexpected results and synergistic effects which is not taught or suggested by the combination of Giencke, Zindel, Hirata and Takematsu.

Moreover, since the final rejection, the USPTO and the EPO have announced their cooperation in the Patent Prosecution Highway. Although the present application does not qualify for this program, it is still instructive to note that claims substantially similar to those pending in the present application were allowed in the corresponding EP application (now EP 1113720 B1) – see attached claims, which provides further evidence that one of ordinary skill would deem the applicants' claimed invention to be non-obvious over the combination of

² "When prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker *must start over*. . . . *An earlier decision should not*, as it was here, be considered as set in concrete, and applicant's rebuttal evidence then *be evaluated only on its knockdown ability*. Analytical fixation on an earlier decision can tend to provide that decision with an undeservedly broadened umbrella effect. Prima facie obviousness is a legal conclusion, not a fact. Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, *not against the conclusion itself*. . . . [A] final finding of obviousness may of course be reached, but such finding will rest upon evaluation of all facts in evidence, uninfluenced by any earlier conclusion reached by an earlier board upon a different record." In *re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Giencke, Zindel, Hirata and Takematsu (the Hirata and Takematsu references were also cited during the EP prosecution).

For these reasons, the applicants claimed invention is unobvious over the combination of Giencke , Zindel, Hirata and Takematsu.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/
Marilyn M. Brogan Howard C. Lee
Reg. No. 31,233 Reg. No. 48,104
Telephone: (212) 588-0800
Facsimile: (212) 588-0500